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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/111,482	07/08/1998	HIROSHI KIGUCHI	101111	5867

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EXAMINER
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YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

33

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/111,482

Applicant(s)

KIGUCHI ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/12/2003 (copy of 12/03/2002 response).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14,16-18 and 20-35 is/are pending in the application.
- 4a) Of the above claim(s) 18,20-31 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14,16,17 and 32-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Applicants' election with traverse of Group I, claims 1, 2, 4-14, 16, 17 and 32-34, in Paper No. 32 is acknowledged. The traversal is on the ground(s) that the subject matter of all pending claims is sufficiently related that a thorough search for the subject matter of one group of claims would encompass a search for the subject matter of the remaining claims. Applicants argue that the search and examination of the entire application can therefore be made without serious burden. This is not found persuasive because the search necessary to determine the patentability of Group II is not the same as the search necessary to determine the patentability of Group I. While a search of the subject matter of Group I may find references disclosing a method of manufacturing an EL element using the composition of Group I, there are many methods of manufacturing EL elements that do not require discharging a composition from a head by an ink-jet method or discharging a composition from a nozzle as required by Group II.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 18, 20-31 and 35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper No. 32. (Withdrawn process claims will be subject to rejoinder upon allowance of a product claim provided the conditions for rejoinder are met. See MPEP 821.04.)

3. Claims 1, 2, 4-14, 16, 17 and 32-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claim 1 requires at least one kind of fluorescent dye “having no substituent that is able to combine with the precursor.” Independent claim 32 requires at least one kind of dye “having no substituent that is able to combine with the precursor.” Independent claims 33 and 34 require at least one kind of dye “having no substituent that is able to combine with the polymer compound.” The language regarding ability to combine with a precursor or polymer compound is not found in the application as originally filed. The limitations imposed by this language are not clear as noted in the rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth later in this Office action. Since the limitations imposed by this language are not clear, it is not clear that the inventors had possession of the claimed invention at the time the application was filed.

Independent claims 32-34 require a dye for determining an emitted color of a luminescent layer. The original application only discloses fluorescent dyes. The broad recitation of “dye” as opposed to the narrower original disclosure of “fluorescent dye” encompasses embodiments not clearly in the possession of the inventors at the time the application was originally filed.

Independent claims 33 and 34 require a polymer compound whereas the original disclosure pertained to conjugated polymer compounds. The broad recitation of “polymer compound” as opposed to the narrower original disclosure of “conjugated polymer compound” encompasses embodiments not clearly in the possession of the inventors at the time the application was originally filed.

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4. Claims 1, 2, 4-14, 16, 17 and 32-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the term "kind" renders the claims indefinite. It is not certain what is meant by a "kind" of fluorescent dye or "kind" of dye.

It is not clear what is meant by the term "combine" in requiring a fluorescent dye or dye having no substituent that is able to combine with the precursor. It is not clear if the claim language refers to chemically reacting or physical mixing or something else. The scope of dyes encompassed by the present claim language is not clear.

5. The following prior art rejections are made subject to clarification as to what is encompassed by a "dye having no substituent that is able to combine with the polymer compound."

In addition to the references applied in the following prior art rejections, there are several other prior art references of record that anticipate the subject matter of claims 33 and 34 subject to clarification of the limitations regarding the dye. The applied references are considered to be representative of the applicable art of record.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Kessler et al. (5,610,932).

See the whole patent. In particular, see column 5, line 64-c. 7, l. 37, c. 9, l. 48-67 and the claims. The doped gel disclosed and claimed by Kessler et al. meets the limitations of a composition as claimed in present claim 33.

8. Claims 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Mori et al. (5,281,489).

See the whole patent. In particular, see Example 1 in column 30 and claims 1, 7-9 and 22-27. The electroluminescent element of Mori's Example 1 is a specific example of an organic element that meets the limitations of present claim 34; the composition used to form the luminescent layer of Example 1 meets the limitations of present claim 33.

9. Claims 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohnishi et al. (5,821,002).

See the whole patent. In particular, see the abstract and column 15, lines 45-66.

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10. Miscellaneous:

In line 3 of claim 1 and in line 2 of claim 32, "conjugate" should read --conjugated--.

In line 3 of claim 32, "lest" should read --least--.

11. The examiner acknowledges receipt of four sheets of formal drawings filed June 25, 2002.

12. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for Art Unit 1774 is (703) 872-9306 for all official faxes. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY  
January 20, 2004



MARIE YAMNITZKY  
PRIMARY EXAMINER

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